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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,003	09/14/1998	LUIS ENJUANES SANCHEZ	ACY-33261	7916

7590 11/17/2004
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
1300 I STREET, N.W.
WASHINGTON, DC 20005

EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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DEA/FCE-1994

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/155,003	09/14/1998	Sanchez, Enjuanes, et al.	ACY-33261

EXAMINER	
Jeffrey S. Parkin, Ph.D.	
ART UNIT	PAPER NUMBER
1648	11082004

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application
Commissioner of Patents

The information disclosure statement filed 23 May, 2003, fails to comply with 37 C.F.R. § 1.97(d) because it lacks a statement as specified in 37 C.F.R. § 1.97(e) and the fee set forth in 37 C.F.R. § 1.17(p). Moreover, the PTO-1449 also fails to identify the instant application. It has been placed in the application file, but the information referred to therein has not been considered.

Applicants are reminded that an information disclosure statement will be considered by the examiner if filed on or after the mailing date of any of the following: a final action under 37 C.F.R. § 1.113; a notice of allowance under 37 C.F.R. § 1.311; or an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

- (A) a statement as specified in 37 C.F.R. § 1.97(e) (see the discussion in subsection B(5); and,
- (B) the fee set forth in 37 C.F.R. § 1.17(p).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. Payment of the fee (37 C.F.R. § 1.17(p)) and submission of the appropriate statement (37 C.F.R. § 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 C.F.R. § 1.98 are satisfied.

A statement under 37 C.F.R. § 1.97(e) must state one of the following:

- (1) that each item of information contained in the information

disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or,
(2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the statement.

The requirements of 37 C.F.R. § 1.97 provide for consideration by the Office of information which is submitted within a reasonable time, i.e., within 3 months after an individual designated in 37 C.F.R. § 1.56(c) becomes aware of the information or within 3 months of the information being cited in a communication from a foreign patent office in a counterpart foreign application. This undertaking by the Office to consider information would be available throughout the pendency of the application until the point where the patent issue fee was paid. **If an applicant chose not to comply, or could not comply, with the requirements of 37 C.F.R. § 1.97(d), the applicant may file a RCE under 37 C.F.R. § 1.114, or a continuing application under 37 C.F.R. § 1.53(b) (or 37 C.F.R. § 1.53(d) if the application is a design application) to have the information considered by the examiner.** If the applicant files a continuing application under 37 C.F.R. § 1.53(b), the parent application could be permitted to become abandoned by not paying the issue fee required in the Notice of Allowance. If the prior application is a design application, the filing of a continued prosecution application under 37 C.F.R. § 1.53(d) automatically abandons the prior application. See the discussion in subsection I. above under the heading "IDS IN CONTINUED EXAMINATIONS AND CONTINUING APPLICATION." **No extensions of time for filing an information disclosure statement are permitted under 37 C.F.R. § 1.136(a) or (b).**

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 9:30 AM to 7:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, James C. Housel, can be reached at (571) 272-0902. Direct general inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Formal communications may be submitted through the official facsimile number which is (703) 872-9306. Hand-carried formal communications should be directed toward the customer window located in Crystal Plaza Two, 2011 South Clark Place, Arlington, VA. Applicants are directed toward the O.G. Notice

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Applicants: Sanchez, E., et al.

for further guidance. 1280 O.G. 681. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Respectfully,

A handwritten signature in black ink, appearing to read 'Jeffrey S. Parkin', with a long horizontal flourish extending to the right.

Jeffrey S. Parkin, Ph.D.
Primary Examiner
Art Unit 1648
08 November, 2004